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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,696	03/09/2000	James Keith	22058-521	2455
30623	7590	02/24/2005	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			SEHARASEYON, JEGATHEESAN	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/521,696		KEITH ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Jegatheesan Seharaseyon		1647	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-11,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-11,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/9/2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/25/2005 has been entered. An action on the RCE follows.

2. Amendments and remarks/arguments filed 7/13/2004 (after final) and 1/25/2005 have been entered. Applicants have cancelled claim 6. Thus, claims 1-5, 7-11 and 21-22 are pending.

3. The Office also acknowledges the drawings submitted on 3/9/2000.

4. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

5. Applicant's declaration submitted under 37 CFR 1.132 and filed on 1/25/2005 is not adequate to overcome the art rejection (Hill et al 1998). See MPEP 715.01(c) and 2132 for the appropriate wording to overcome the art rejection (see below for 715.01(c)).

“ Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf.

Since such a showing is not made to show a date of invention by applicant prior to the date of the reference under 37 CFR 1.131, the limitation in 35 U.S.C. 104 and in 37

CFR 1.131(a)(1) that only acts which occurred in this country or in a NAFTA or WTO member country may be relied on to establish a date of invention is not applicable. Ex

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parte Lemieux, 115 USPQ 148, 1957 C.D. 47, 725 O.G. 4 (Bd. App. 1957); Ex parte Powell, 1938 C.D. 15, 489 O.G. 231 (Bd. App. 1938). See MPEP § 716.10 regarding 37 CFR 1.132 affidavits submitted to show that the reference is a publication of applicant's own invention.

#### I. >< CO-AUTHORSHIP

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)."

#### ***Claim Rejections - 35 USC § 102, withdrawn***

6. Rejection of claim 6 under 35 U.S.C. §102 (b) as being anticipated by Yang et al. (U.S. Patent No. 5, 700,664) is withdrawn because Applicants have cancelled the claim.

#### ***Claim Rejections - 35 USC § 102, maintained***

7. Claims 1 and 21 remain rejected under 35 U.S.C. §102 (a) as being anticipated by Hill et al. (1998), is maintained for reasons set forth 5/5/2003 and 2/17/2004. Applicant's arguments filed on 7/13/2004 and 1/25/05 have been considered but are not persuasive

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for reasons indicated above in paragraph 5. Therefore, claims 1 and 21 remain rejected under 35 U.S.C. §102 (a) as being anticipated by Hill et al. (1998).

***Claim Rejections - 35 USC § 103, maintained***

8. Claims 2-5, 7-11 and 22 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Hill et al. (1998) in view of Yang et al. (U.S. Patent No. 5,700,664) is maintained for reasons set forth 5/5/2003 and 2/17/2004. Applicant's arguments filed on 1/25/05 and 2/17/2004 have been considered but are not persuasive for reasons indicated above in paragraph 5. Therefore, instant invention is obvious over Hill et al. (1998) in view of Yang et al. (U.S. Patent No. 5,700,664).

9. No claims are allowable over prior art.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jegatheesan Seharaseyon whose telephone number is 571-272-0892. The examiner can normally be reached on M-F: 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS2/05



JANET ANDRES  
PRIMARY EXAMINER